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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/720,668

11/25/2003

Otto E. Anderhub

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EXAMINER

BACHMAN, LINDSEY MICHELE

ART UNIT

PAPER NUMBER

3734

MAIL DATE

DELIVERY MODE

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PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/720,668	<b>Applicant(s)</b> ANDERHUB ET AL.	
	<b>Examiner</b> LINDSEY BACHMAN	<b>Art Unit</b> 3734	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 03 March 2008.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☐ Claim(s) 1,2,6-27,31-50,52-65 and 87-94 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1,2,6-27,31-50,52-65 and 87-94 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 03 March 2008 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)            | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | Paper No(s)/Mail Date. _____                                      |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>3-3-08</u> .  | 6) <input type="checkbox"/> Other: _____                          |

## **DETAILED ACTION**

### ***Continued Examination Under 37 CFR 1.114***

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 3 March 2008 has been entered.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of

the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

**Claims 1, 2, 12, 15, 17 and 20-27, 36 are rejected under 35 U.S.C. 103(a) as obvious over Paternuosto (WO 01/30242 A1) in view of Jaeger (US 4,763,669) and in further view of Dowd (US Patent 1,609,014).**

Claim 1, 2, 12, 15, 17, 20-25, 37, 38, 39, 41, 44-49: Paternuosto discloses a forceps having a first jaw (10a) and a second jaw (10b). The second jaw has a cutting edge (12), a holder (rest of 10b shown in fig. 7) and a storage portion (22). The storage portion has holes 24. The holder portion has a groove shown in fig. 9 for receiving a lip on the storage portion. The two jaws are pivotally attached to each other. Each of the jaws has a sharpened cutting edge for mating together to cut tissue. The storage portion receives the cut tissue for biopsy. The examiner contends that the holder portion is configured to receive the cutting portion because it is integral therewith and since it does receive it, or is attached to it, it therefore is configured to receive it. The claim is not limited to some means to receive it. However, in any event, if it is not deemed to disclose this limitation, the examiner turns to Jaeger. Jaeger teaches that it was known to removably attach a cutting edge to a biopsy forceps in order to be re-sharpened see col. 2 lines 33-36. The means is a slot or groove in the holder or jaw. Therefore, it would

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have been obvious to have removably attached the blade edge 12 of Paternuosto to the rest of the holder of the jaw, in order to allow for sharpening. Regarding the limitation of Claim 16, requiring a handle, Paternuosto does not explicitly disclose a holder, however Jaeger shows a handle for controlling the distal end effector. It would have been obvious to modify Paternuosto with a handle because the end effector necessarily needs a means to open and close the jaws.

Neither Paternuosto'242 nor Jaeger teach the use of protrusion on the cutting edge that engages with the holder. Dowd teaches that it is known to provide a cutting device (22) with a protrusion (edge) for engaging with a groove (18, 19) in the holder (12). It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the device of Paternuosto in view of Jaeger with the groove/protrusion taught by Dowd in order to provide a secure attaching mechanism between the blade and the holder.

**Claims 6-11, 13, 14, 18, 19, 31-35, 42-43 are rejected under 35 U.S.C. 103(a) as being unpatentable over Paternuosto in view of Jaeger'669 and Dowd'014.**

Paternuosto discloses or makes obvious the invention as claimed with the exception of the specific cutter portion attachment means, or the materials of the different components.

Jaeger and Dowd both disclose a biopsy forceps as described above.

It would have been obvious to have provided the groove on the holder for receiving the cutter, as this has proven to be a convenient means for removably attaching the edge to the jaw for the purposes of sharpening the cutter. As for the

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different materials, same materials, metal, non-metal materials of the different components, the examiner contends that such is nothing more than a mere obvious design choice. Cutting edges were previously known as being manufactured out of plastic or metal. Forming two removable components out of different materials would allow for one material to be sharpened and the other material to be less expensive, for example.

**Claim 16, 40, 50, 52-65, 87-94 is rejected under 35 U.S.C. 103(a) as obvious over Paternuosto (WO 01/30242 A1) in view of Jaeger'669 and Dowd'014 and in further view of Kortenbach et al. (US Patent 5,707,392).**

Claim 50, 56, 58, 61, 62, 63, 64, 65, 87-94 : Paternuosto in view of Jaeger'669 and Dowd'014 disclose the limitations of Claim 50, as described above, except for a second end effector (blade) having a non-straight tang connecting the cutting edge to the holder.

Kortenbach'392 discloses a tang (58) connected to cutting edge (56) that is configured to be received with the holder (40). It would be obvious to one of ordinary skill in the art at the time the invention was made to have the configuration of Kortenbach'392 in order to aid in pivotally opening and closing the end effector assembly.

Claim 52-55, 57, 59, 60: Paternuosto discloses or makes obvious the invention as claimed with the exception of the specific cutter portion attachment means, or the materials of the different components.

Jaeger and Dowd both disclose a biopsy forceps as described above.

It would have been obvious to have provided the groove on the holder for receiving the cutter, as this has proven to be a convenient means for removably attaching the edge to the jaw for the purposes of sharpening the cutter. As for the different materials, same materials, metal, non-metal materials of the different components, the examiner contends that such is nothing more than a mere obvious design choice. Cutting edges were previously known as being manufactured out of plastic or metal. Forming two removable components out of different materials would allow for one material to be sharpened and the other material to be less expensive, for example.

### ***Response to Arguments***

Applicant's arguments with respect to claims have been considered but are moot in view of the new ground(s) of rejection.

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to LINDSEY BACHMAN whose telephone number is (571)272-6208. The examiner can normally be reached on Monday to Thursday 7:30 am to 5 pm, and alternating Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jackie Ho can be reached on 571-272-4696. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/L. B./

Examiner, Art Unit 3734

/(Jackie) Tan-Uyen T. Ho/

Supervisory Patent Examiner, Art Unit 3773